02280.002720 PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	:	Examiner: J.D. Janvier
HENRY V. IZZO ET AL.	)	
	:	Art Unit: 3622
Application No.: 09/855,585	)	
	:	
Filed: May 16, 2001	)	
	:	
For: METHOD AND APPARATUS FOR ADMINISTERING A GAME OR CONTEST ON THE WORLD-WIDE-WEB (as amended)	) :) :	September 28, 2006

Mail Stop: Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO MISCELLANCEOUS COMMUNICATION

Sir:

A Miscellaneous Communication was mailed in this application on August 28, 2006, setting a one-month period for response. The Examiner alleges that the claims as amended by the Amendment filed on May 31, 2006, are not supported by the specification. In particular, the Examiner states the following:

> First, the step of establishing a subset of items, which covers the entire claimed invention starting with claim 1, is not described in the specification related to the PGPUB version of the Instant Application.
>
> Second, the step of allowing the consumer to enter a contest code into a prize redemption system, as featured in at least the independent claims, is not supported in the specification. Here, the identification code read from the label of the product provided to the consumer and inputted into a prize redemption system, as described in the specification is not the same as the contest code since the identification code, contrary to Applicant's findings, is similar to the UPC code found on product labels.

Applicants respectfully disagree with the above two statements and address each statement individually, as follows:

FIRST STATEMENT

The Examiner alleges that the step of "establishing a subset of items" recited in Claim 1 is not described in the specification (emphasis provided in the Miscellaneous Communication). This step recites, in its entirety, the following: "establishing a subset of a plurality of items produced by a manufacturer, wherein each item of the subset includes a winning code unique to the subset."

An illustrative example of this step is the situation in which a manufacturer produces 100 bottles of shampoo ("a plurality of items") of which only 10 of those bottles ("a subset") include a winning code. In this example, the winning code is unique to those 10 bottles of shampoo and is not included in the other 90 bottles of shampoo produced by the manufacturer.

Support for the step in question may be found in the specification (see U.S. Patent Application Publication No. 2002/0016737) as follows:

(1) The Background of the Invention section (paragraphs [0002] through [0013]) describe previous ways in which manufacturers promote the purchase of a product through the use of incentive games or contests associated with the product. This section also includes statements indicating that the present invention utilizes the World Wide Web to provide consumers with "the opportunity to participate in a contest of chance, affording the opportunity to win prizes," that avoids certain problems in prior-art promotional contests. Thus, this section supports the feature of a manufacturer promoting the purchase of a product through the use of a promotional game or contest.

(2) Paragraph [0041] discloses an embodiment in which "certain of the codes" may be pre-associated with a prize, while other codes are not associated with the prize. Thus, this section supports the feature of a winning code being established for a subset but not all of a plurality of items of the product produced by a manufacturer. Applicants note that this paragraph also supports the position that the code of the present invention is not a UPC code, because each one of the plurality of items of the product would have the same UPC code and therefore would not conform with certain of the codes being associated with a prize while other codes are not.

(3) Paragraphs [0038] to [0039] disclose embodiments in which there is a "previous assignment" of a winning code or codes, with the non-winning code(s) being "losing codes." Applicants submit that this further supports the feature of a winning code being established for a subset but not all of a plurality of items of the product produced by the manufacturer.

Finally, the feature of "a subset" of the plurality of items including a winning code was discussed with the Examiner in a personal interview on March 23, 2006, conducted with Thomas Collins, who is one of the inventors, and Raymond Mandra, who is Applicants' attorney. The Examiner looked upon this feature favorably during the interview, and therefore the claims were amended to include this feature.

SECOND STATEMENT

The Examiner alleges that the feature of allowing a consumer to "enter a contest code into a prize redemption system" as claimed in the independent claims is not supported in the specification (emphasis provided in the Miscellaneous Communication). In particular, the

Examiner believes that the term "identification code" cannot be a contest code but is "similar to the UPC code found on product labels."

Applicants respectfully traverse this statement and the characterization of Applicants' invention therein for at least the following reasons:

(1) Support for the identification code being a contest code may be found in paragraph [0015], which states that an aspect of the present invention is directed to a method of administering a promotional ***contest***. Also, the second sentence of paragraph [0015] describes the step of determining whether the identification code is a winning code that entitles the consumer to receive a prize. Applicants respectfully submit that it would be clear to one of ordinary skill in the relevant art that an identification code is also a contest code if the identification code could be a winning code associated with a prize. Thus, Applicants respectfully submit that codes associated with such a promotional contest properly may be described as ***contest*** codes. That is, the term "identification code" properly may be interchanged with the term "contest code."

(2) Paragraph [0033] discloses that identification codes may fall into one of several different classes: "expired, redeemed, winning, pending and losing." These code classes are respectfully submitted to be classes of ***contest codes***, thus supporting the language in the claims.

(3) As discussed above, paragraph [0038] states that "any identification code or number associated with a prize is previously assigned as a winner/loser and the consumer, upon checking in to the prize redemption Web site, is instantly advised as to their prize status upon entry of the code." This disclosure further supports the position that the term "identification code" refers to a ***contest code***.

(4) As discussed above, Paragraph [0041] discloses an embodiment in which "certain of the codes" may be pre-associated with a prize, while other codes are not associated with the prize. Thus, this section supports the feature of a winning contest code being established for a subset but not all of a plurality of items of the product produced by the manufacturer, which eliminates the possibility that a UPC code could be used as the code of the claims. Again, the code of the claims cannot be a UPC code, because each one of the plurality of items produced by the manufacturer would have the same UPC code and therefore would negate the "contest" aspect of the invention. (Applicants question how there can be a contest if either everyone wins or everyone loses because every one of the plurality of items produced by the manufacturer has the same code.) It is respectfully submitted that UPC codes could not reasonably be the code of the claimed invention. The Amendment and supporting documents filed on May 31, 2006, includes an extensive explanation of the UPC convention and why UPC codes are not applicable to the invention as claimed. Applicants respectfully refer the Examiner to that explanation.

(5) The term "contest code" may be found in paragraph [0050], which states that "for verification purposes, ***contest code*** and code date . . . can be checked by the server so that the manufacturer remains aware of what prize codes were associated with which codes dates." (Emphasis added.) Applicants respectfully submit that this further supports the position that a contest code could not be a UPC code, because a UPC code is not associated with a "code date." That is, a bottle of shampoo manufactured in 2005 would have the same UPC code as an identical bottle of shampoo manufactured in 2006. Applicants refer the Examiner to the Amendment and supporting documents filed on May 31, 2006, for a more detailed explanation of the UPC convention.

Finally, the substitution of the term "contest code" for the term "identification code" was discussed with the Examiner in the personal interview mentioned above. The Examiner looked upon this change favorably during the interview, and therefore the claims were amended to include the term "contest code."

OTHER STATEMENT

The Miscellaneous Communication includes the following statement that appears to indicate a degree of hostility towards this application:

> The amendment is so inclusive or invasive that it impedes prosecution such that a patentability determination cannot be made at this time.

Applicants respectfully request the Examiner to withdraw this statement, because the tone of the statement is accusatory and could be interpreted to suggest that Applicants filed the Amendment of May 31, 2006, to impede prosecution. Applicants respectfully submit that all the papers submitted in the application are intended for the sole purpose of obtaining a patent for the claimed invention. Papers that are submitted to clarify the state of the art should not be considered to "impede prosecution." Claim amendments that further clarify the claimed invention should not be considered to be "invasive." Applicants respectfully submit that such harsh language is out of place in an objective examination process.

Additionally, as mentioned above, substitution of the term "contest code" for the term "identification code" and the feature of "a subset" of the plurality of items including a winning code were discussed with the Examiner in the personal interview conducted on March 23, 2006. During the interview, Applicants received positive feedback from the Examiner for incorporation of such language in the claims. In view of this positive feedback, Applicants

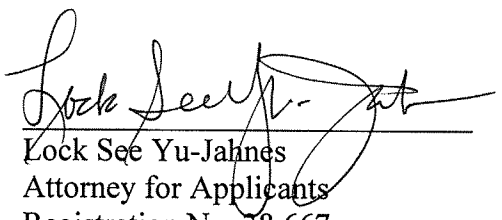
amended the claims to include the language now questioned by the Examiner. The changes to the claims were made for the sole purpose of advancing and not impeding the prosecution of the present application.

A formal withdrawal of the above-quoted statement is respectfully requested.

No petition to extend the time for response is deemed necessary for the present Response to Miscellaneous Communication. If, however, such a petition is required to make this Response timely filed, then this paper should be considered such a petition and the Commissioner is authorized to charge the requisite petition fee to Deposit Account 06-1205.

Applicants' undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,



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